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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,638	10/24/2003	Charlotte Famy	244625US0	7606

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EXAMINER

MARCANTONI, PAUL D

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/691,638	Applicant(s) FAMY ET AL.	
	Examiner Paul Marcantoni	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11, 12, 16, 18, 21, 24, 26 and 29-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 12, 16, 18, 21, 24, 26 and 29-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

New Matter:

Claims 9,11,12,16,18,21,24,26, and 29-36 are rejected under the first paragraph of 35 USC 112 as the specification as originally filed does not provide support for the invention as is now claimed.

The lower limit range of 18% by weight cement in claims 9 and 29 is new matter. Applicants do not have support for a range of 18% as a lower limit but of a range of "between" 18 to 75 wt% or in the claimed invention between 18 to 50 wt% (see p.4, line28 of applicants' specification). Applicants can insert the term ---between--- in claims 9 and 29 to overcome this issue. Note that there is not a clarity or agreement on the word between. Some say that between 1 and 5, for example, does not include the endpoints one and 5 because the data range is between these endpoints. Others argue that they do include those endpoints. Regretfully, the examiner is unaware of any clarification for the word "between" from case law or MPEP guidelines and thus the dilemma.

The same situation arises for new matter with respect to the upper endpoint or limit of 70 wt% calcium carbonate. However, the applicants' claims 9 and 29 are new matter because on page 7, line 6, their specification requires that the range of calcium carbonate is "between" 30 and 70 wt%. Thus Applicants would appear to need the term "between" if they are to claim the range (upper) of 70 wt% because that is what is called for by their own specification.

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35 USC 112 Second Paragraph:

Claims 9,11,12,16,18,21,24,26, and 29-36 are rejected under the second paragraph of 35 USC 112 as failing to particularly point out and distinctly claim applicants' invention.

The limitation "from 2 to 10% by wt. of fibers, *at least some of which are synthetic fibers*" is indefinite. How many fibers in weight percent do applicants mean by some? Can all the fibers be synthetic and what are they if they are not synthetic? It seems they can be virtually any type of fiber. Can also none of the fibers be synthetic and still obtain the applicants' objectives for the properties of their flat panel? See claims 9 and 29.

The term "fly ashes" should be properly amended to -fly ash—in claim 16.

In claim 36, the terms "fly ashes selected from the group consisting of rice hush ashes and blast furnace slag" are indefinite. Note that rice husk ash is materially different than fly ash obtained from a coal burning power plant. Also, it is proper to say fly ash and rice husk ash. The claim also seems to indicate blast furnace slag is an ash which it is not. Applicants can amend to ---rice husk ash and blast furnace slag--- as a substitute for the indefinite terms to resolve this problem.

Famy Declaration under 37 CFR 1.132:

The examiner has reviewed this declaration and it is not convincing over the examiner's rejection nor is it commensurate in scope with respect to the "claimed" invention. Applicants are referred to the declaration on page 2 wherein it states a specific cement (ordinary Portland cement or Portland cement), cellulose (fibers?), and

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polyvinyl alcohol (fibers?) in Table 1. There is no indication of the presence of Portland cement, cellulose or polyvinyl alcohol in independent claims 9 and 29 and thus applicants' declaration fails to be convincing because of this problem.

35 USC 103:

Claims 9,11,12,16,18,21,24,26, and 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US Patent No. 4,428,775) or Merkley et al. (US Patent No. 6,777,103 B2).

The applicants argue Johnson et al. (hereafter Johnson) with respect to preferred embodiments and examples. Yet, a reference is good for all that it realistically teaches and is not limited to preferred embodiments or examples. The applicants argue in boldface on page 7 of their response that the amount of Portland cement is "preferred" to be 55-65% Portland cement when silica and/or filler is used. Yet, it does not have to be and could in fact be the broadest ranges in accordance with the teachings of claim 1 and the teaching on line 58 of column 2 of 40 to 80 wt% cement. Again, a reference is not limited to its preferred embodiments but all that it realistically teaches. It is the examiner's position that the ranges of amounts of components overlap the instantly claimed invention. As for the Famy declaration, it is not convincing because it is not commensurate in scope with their own claimed invention for the reasons as provided above.

The applicants argue Merkley et al. stating that Merkley et al. prefers a composition containing 10-80% cement binder, 20-80% silica, 0-10% of additives (col.9, line 43-53). The applicants then go on to state that "calcium carbonate" is not included

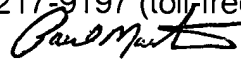
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and not disclosed for "any embodiment" and thus fails to present a case of prima facie obviousness. The examiner disagrees as the applicants seem to have forgotten or somehow ~~inadvertently~~ ^{inadvertently} omitted a major component in their listing of ingredients from column 9, lines 43-53. How about the third listed component of **density modifiers** in amounts of 0 to 50%? Merkley clearly teaches that applicants' comments are factually incorrect because he teaches **calcium carbonate** as a density modifier in column 9, line 22. It is not certain how the Famy declaration would necessarily overcome this reference either because all components are taught and this declaration, as mentioned previously, is not commensurate in scope with applicants' "claimed" invention.

Suzuki '620:

This reference has now been added to the submitted PTO-892 and thus made of official record per applicants' request.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


Paul Marcantoni
Primary Examiner
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